

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

MEDIA CHAIN LLC,
Patent Owner.

IPR2022-00389 (Patent 9,715,581 B1)
IPR2022-00390 (Patent 9,898,590 B2)
IPR2022-00391 (Patent 10,489,560 B2)
IPR2022-00392 (Patent 10,515,191 B2)
IPR2022-00393 (Patent 10,860,691 B2)
IPR2022-00394 (Patent 10,885,154 B2)¹

Before JUSTIN T. ARBES, TERRENCE W. McMILLIN, DANIEL J. GALLIGAN, and SCOTT RAEVSKY, *Administrative Patent Judges*.²

McMILLIN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

¹ This Decision applies to all of the above-listed proceedings. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading.

² This is not an expanded panel. Each of the listed judges is part of a three-judge panel assigned to the listed proceedings.

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I. INTRODUCTION

On June 1, 2022, with our authorization, Petitioner, Roku, Inc., filed Unopposed Motions to Dismiss the Petitions for *Inter Partes* Review in the above-referenced proceedings (collectively, “Unopposed Motions”). Paper 4.³ Along with the Unopposed Motions, Petitioner filed copies of a Settlement Agreement between the Parties (Ex. 1100), as well as Unopposed Requests to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (collectively, “Unopposed Requests to Keep Settlement Agreement Confidential”). Paper 5.

II. DISCUSSION

In the Unopposed Motions, Petitioner represents that “[t]he parties have settled all disputes relating to the challenged patent[s].” Paper 4, 2. Petitioner also represents that the parties have agreed to terminate the district court litigation between the parties associated with the challenged patents and that “[t]he parties do not contemplate any other litigation or proceeding between the parties concerning the [challenged] patent[s] in the foreseeable future.” *Id.*

With regard to the Settlement Agreement (Ex. 1100), the Unopposed Motions state:

Petitioner is filing herewith as Exhibit 1100 a true copy of the confidential settlement agreement entered between the parties. *See* 37 C.F.R. § 42.74(c). The confidential settlement

³ All citations are to the record in IPR2022-00389 as the pertinent papers and exhibits in all six proceedings have substantially the same substantive content.

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agreement was entered into in contemplation of the dismissal of the Petition. There are no collateral agreements or understandings made in connection with, or in contemplation of, the dismissal of the Petition. *See* 37 C.F.R. § 42.74(b).

Id. at 1–2. Further, in the Unopposed Requests to Keep Settlement Agreement Confidential, Petitioner requests that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the respective patents involved in the above-identified *inter partes* review proceedings. Paper 5, 1.

In the Unopposed Requests to Keep Settlement Agreement Confidential, Petitioner additionally requests “that the Board order that in the event a person or entity makes a written request for access to the settlement agreement, . . . any such written request be served upon Petitioner and Patent Owner on the day the written request is provided to the Board.” Paper 5, 1. We have no such procedure to serve upon the parties a request for access to the Agreement, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding requiring that any requests to access the Settlement Agreement be served upon any of the parties.

Patent Owner has not properly appeared in any of these proceedings. Patent Owner was required by 37 C.F.R. § 42.8 to file with the Board within 21 days of service of the Petitions its mandatory notices. As the Petitions were filed and served on January 10, 2022 (*see* Paper 2, attached un-numbered page titled Certification of Service (37 C.F.R. §§ 42.6(e), 42.105(a)), Patent Owner’s mandatory notices are long overdue but have not

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been filed. Pursuant to 37 C.F.R. § 42.10(b), “[a] power of attorney must be filed with the designation of counsel.” Patent Owner has not filed a power of attorney in any of these proceedings or otherwise designated or identified counsel.

At the request of Christopher A. Estes, who represented to us that he is the Managing Partner of Media Chain LLC (Patent Owner), a teleconference was held in these proceedings on May 31, 2022, including Mr. Estes, Petitioner’s counsel Lestin L. Kenton,⁴ and the Board. The Board informed Mr. Estes that mandatory notices and designation or identification of counsel were required and long overdue. Mr. Estes indicated that he was aware of the settlement of the litigation, had been provided with copies of the Unopposed Motions and the Unopposed Requests to Keep Settlement Agreement Confidential,⁵ and wished the Board to terminate these proceedings.

We determine that Patent Owner has been provided with notice of these proceedings, has failed to comply with 37 C.F.R. § 42.8 by failing to file its mandatory notices, and has waived its right to appear in these proceedings.⁶

⁴ Mr. Kenton agreed to provide a copy of this Decision to Mr. Estes. This courtesy is appreciated.

⁵ In addition, the Unopposed Motions and the Unopposed Requests to Keep Settlement Agreement Confidential each include a “Certification of Service” certifying that true and correct copies were sent by email to Mr. Estes. Paper 4, un-numbered last page; Paper 5, un-numbered last page.

⁶ However, even in the absence of this waiver, our determination to terminate these proceedings would be the same.

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These proceedings are at an early stage, and we have not yet decided whether to institute a trial in any of these proceedings. Petitioner moves to dismiss these proceedings, and Patent Owner has failed to properly appear in any of these proceedings. Further, both Petitioner and Mr. Estes desire that these proceedings be terminated. And Petitioner represents that “Petitioner and Patent Owner have agreed to terminate [the district court] litigation pursuant to their confidential settlement agreement.” Paper 4, 2. Under these circumstances, it is appropriate to terminate these proceedings and not institute trial in any of these proceedings.

Further, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep the Settlement Agreement separate from the files of the patents in the above-identified *inter partes* review proceedings pursuant to 37 C.F.R. § 42.74(c).

Finally, we want to provide Patent Owner with an additional opportunity to appear in these proceedings by filing mandatory notices and designating or identifying counsel. And, if Patent Owner avails itself of the opportunity to properly appear in any of these proceedings, we want to provide Patent Owner with the opportunity to object or otherwise respond to this Decision and the Unopposed Motions to Dismiss and the Unopposed

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